

REMARKS

Claims 1-17 remain pending, with claims 15-17 withdrawn from consideration.¹ Claims 1, 2, 5, 8, 9, and 11-14 are currently amended, and claim 4 is canceled. No claims are added.

The Office Action indicates on page 3 that applicants must confirm that they elect claims 1-14 for prosecution. Accordingly, applicants hereby confirm that they elect claims 1-14 for prosecution.

Claims 1, 4-6, 8, 10, and 11 stand rejected under the doctrine of obviousness-type double patenting as unpatentable over claims 49, 50, 52, 54-57, 59, and 61 of *Ohnishi et al.*, U.S. Patent No. 6,525,932. As discussed above, claim 4 is canceled, thereby rendering its rejection moot. Regarding claims 1, 5, 6, 8, 10, and 11, applicants respectfully traverse the rejection.

As shown above, claims 1 and 11 are now amended to recite the subject matter previously recited in claim 4. That is claim 1 now describes an expansion unit that has:

a cable for connecting the imaging device to the information processing apparatus when the imaging device is detached from the expansion unit; and
a cable storage compartment inside the expansion unit for storing the cable.

Similarly, claim 11 now describes a portable information processing apparatus that has the subject matter quoted above. Applicants respectfully submit that U.S. Patent No. 6,525,932 neither claims an expansion unit nor a portable information processing apparatus as described in claims 1 and 11, respectively, and U.S. Patent No. 6,525,932 also does not claim an obvious variant of such an expansion unit or portable information processing apparatus, either. Accordingly, the rejection of those claims, and of claims 5, 6, 8, and 10 depending from claim 1, should be withdrawn.

¹ Although the Office Action does not state that claims 15-17 are still pending, applicants did not cancel them.

In the pending application, the imaging device of the present invention may project outwardly from the expansion unit with a changeable view angle, or instead the imaging device may be detached from the expansion unit while having a cable connection with the information processing apparatus. In contrast, U.S. Patent No. 6,525,932 discloses one embodiment in which an imaging device projects outwardly (see, for example, Fig. 8) and separate embodiment in which an imaging device is detached while having a cable connection (see, for example, Fig. 10). These embodiments are mutually exclusive, and moreover no claims in U.S. Patent No. 6,525,932 encompass both embodiments.

In a double-patenting rejection, when considering whether the invention defined in a claim of an application is an obvious variant of an invention defined in the claims of a patent, the disclosure of the subject patent may not be used as prior art. MPEP § 804.² In the present case, it is not proper to selectively pick features from the different embodiments of U.S. Patent No. 6,525,932 until all presently-claimed elements are matched with a corresponding element of the patent. Instead, to properly justify the rejection, the PTO must show why the subject matter described in pending claims 1 and 11 is supposedly an obvious variant of the subject matter that is described in *at least one claim* of U.S. Patent No. 6,525,932.

Applicants submit that such a showing cannot be provided, because pending claims 1 and 11 describe subject matter that differs in a non-obvious fashion from that described in the claims of U.S. Patent No. 6,525,932. Accordingly, claims 1 and 11 should not be rejected as obviousness-type double patenting. Because claims 5, 6, 8, and 10 each depend from claim 1, those claims also should not be rejected as obviousness-type double patenting.

² “[A] double patenting rejection must rely on a comparison *with the claims* in an issued or to be issued patent.” Page 800-20, second column [*emphasis added*].

Therefore, applicants now solicit the withdrawal of the obviousness-type double patenting rejection.

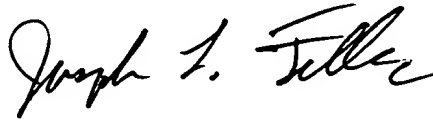
Applicants appreciate the indication in the Office Action that claims 2, 3, 7, 9, and 12-14 would be allowable if claims 2, 7, 9, and 12-14 are rewritten in independent form. As shown above, claims 2, 9, and 12-14 are rewritten independent form. Accordingly, allowance of claims 2, 3, 9, and 12-14 is now requested.

Claim 7 is not rewritten in independent form because it depends from claim 5, and, as discussed above, claim 5 should be allowed. Because claim 7 depends from claim 5, claim 7 should also be allowed for at least the reason of its dependency.

In view of the remarks above, applicants now request submit that the application is in condition for allowance. Accordingly, a Notice of Allowability is hereby requested. If for any reason it is believed that this application is not now in condition for allowance, the Examiner is welcome to contact applicants' undersigned attorney at the telephone number indicated below to arrange for disposition of this case.

In the event that this paper is not timely filed, applicants petition for an appropriate extension of time. The fees for such an extension, or any other fees which may be due, may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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Enclosure: Amendment Transmittal

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